

REMARKS

Claims 1-18 are currently pending. Applicant respectfully requests that the remarks set forth below be considered in conjunction with the remarks previously presented in the Response to Final Office Action, dated August 24, 2009, incorporated herein by reference.

In the Final Office Action, dated June 23, 2009, the Examiner issued a final rejection of independent claims 1, 7, and 13 under 35 U.S.C. § 102(b) as being anticipated by “Microsoft Device Driver for Symbios Logic ATA/ATAPI-to-1394 Controller Included in Microsoft’s New NT5 Beta DDK Release, 10/6/1997” (hereinafter “Microsoft ‘997”).

In Applicant’s Response to Final Office Action, dated August 24, 2009, Applicant respectfully traversed the Examiner’s final rejection, including the final rejection of independent claims 1, 7, and 13 under 35 U.S.C. § 102(b) based on Microsoft ‘997. For example, Applicant argued, *inter alia*, that Microsoft ‘997 fails to teach or suggest converting commands in ATA/IDE standard or Serial ATA standard into commands in IEEE 1394 standard and the Universal Serial Bus standard, as required by claim 1. See Response to Final Office Action, 8/24/2009, p. 8.

In the Advisory Action Before the Filing of an Appeal Brief, dated September 1, 2009, the Examiner argues that “the logic that converts IEEE 1394 commands to ATA commands can easily be used to convert ATA to IEEE 1394 commands.” See Advisory Action, 9/1/2009, continuation sheet. The Examiner’s argument is respectfully traversed.

At the outset, Applicant notes that independent claims currently stand rejected as being anticipated under 35 U.S.C. § 102(b). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See MPEP § 2131. Further, “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Id.*

As implied by the statements made by the Examiner in the Advisory Action, the Microsoft ‘997 does not set forth “each and every element” of the independent claims of the present application, “in as complete detail as is contained in the ... claim.” See MPEP § 2131. Rather, the Examiner argues that the Microsoft ‘997 reference could be *modified* because the logic “can easily be used” to convert ATA to IEEE 1394 commands. See Advisory Action, 9/1/2009, continuation sheet.

Applicant notes that the Examiner appears to be making an argument with respect to obviousness under 35 U.S.C. § 103, as opposed to anticipation under 35 U.S.C. § 102(b).

Further, Applicant notes that, with respect to the independent claims, the Examiner has not issued an obviousness rejection or established a *prima facie* case of obviousness. See MPEP §§ 2142 and 2143.01. Specifically, Applicant respectfully notes that the Examiner’s conclusory statements in the Advisory Action, dated 9/1/2009, are insufficient to establish a *prima facie* case for obviousness. See MPEP § 2142 (“rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) and *KSR International Co. v. Teleflex Inc.*, 550 US 398 (2007); See

also, MPEP § 2143.01(IV) (a “mere statement” that modifications of the prior art to meet the claim limitations would have been within the capabilities of one of ordinary skill in the art is not sufficient to establish *prima facie* obviousness).

For these reasons, Applicants respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that the present application is in condition for allowance. Thus, prompt and favorable consideration of this response is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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